

The opinion in support of the decision being entered today was not written
for publication and is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte JOHN MURRAY JOPLING, PAUL DOMINIC FORSTER,
DAVID CHARLES HOLLAND and RICHARD ELLIOT HALE

Appeal No. 2004-0576
Application No. 10/087,374

ON BRIEF

Before STAAB, McQUADE, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 11,
which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to marine seismic surveying (specification, p. 1). A copy of claims 2 to 11 is set forth in the appendix to the appellants' brief. Claim 1 reads as follows:

A boomer for generating acoustic signals in a marine seismic survey, comprising:
a frame adapted to be towed by a survey vessel,
a coil mounted to the frame,
a conductive plate adjacent to the coil,
a capacitor mounted within the frame, and
a control electronics system mounted within the frame for delivering electric charge stored in the capacitor to the coil.

Claims 1 to 11 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.¹

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the answer (Paper No. 10, mailed May 22, 2003) for the examiner's complete reasoning in support

¹ The rejection of claims 1 to 11 under 35 U.S.C. § 103 made in the final rejection was withdrawn by the examiner in the answer.

of the rejection, and to the brief (Paper No. 9, filed April 8, 2003) and reply brief² (Paper No. 11, filed July 23, 2003) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

An analysis of whether the claims under appeal are supported by an enabling disclosure requires a determination of whether that disclosure contained sufficient information regarding the subject matter of the appealed claims as to enable one skilled in the pertinent art to make and use the claimed invention. The test for enablement is whether one skilled in the art could make and use the claimed invention from the disclosure coupled with information known in the art without undue experimentation. See United States v. Teletronics, Inc., 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988), cert. denied, 109 S.Ct. 1954 (1989); In re Stephens, 529 F.2d 1343, 1345, 188 USPQ 659, 661 (CCPA 1976).

² The declaration of Ian Alexander Millar attached to the reply brief was held by the examiner as being untimely (see Paper No. 12, mailed October 14, 2003). Accordingly, we will not consider that declaration.

In order to make a nonenablement rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. See In re Wright, 999 F.2d 1557, 1561-62, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure). A disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. § 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. Assuming that sufficient reason for such doubt exists, a rejection for failure to teach how to make and/or use will be proper on that basis. See In re Marzocchi, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971). As stated by the court,

it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure.

In re Marzocchi, 439 F.2d at 224, 169 USPQ at 370.

Once the examiner has established a reasonable basis to question the enablement provided for the claimed invention, the burden falls on the appellants to present persuasive arguments, supported by suitable proofs where necessary, that one skilled in the art would be able to make and use the claimed invention using the disclosure as a guide. See In re Brandstadter, 484 F.2d 1395, 1406, 179 USPQ 286, 294 (CCPA 1973). In making the determination of enablement, the examiner shall consider the original disclosure and all evidence in the record, weighing evidence that supports enablement³ against evidence that the specification is not enabling.

Thus, the dispositive issue is whether the appellants' disclosure, considering the level of ordinary skill in the art as of the date of the appellants' application, would have enabled a person of such skill to make and use the appellants' invention without undue experimentation. The threshold step in resolving this issue as set forth supra is to determine whether the examiner has met his burden of proof by advancing acceptable reasoning inconsistent with enablement. This the examiner has not done.

In the rejection before us in this appeal, the examiner states (answer, p. 4) that

³ The appellants may attempt to overcome the examiner's doubt about enablement by pointing to details in the disclosure but may not add new matter. The appellants may also submit factual affidavits under 37 CFR § 1.132 or cite references to show what one skilled in the art would have known at the time of filing the application.

the instant figures and specification fail to disclose how and by what means the capacitors and control circuitry are arranged or mounted or provided within the frame. It is incumbent upon the specification to disclose the specifics of how and by what means the capacitors and control circuitry are arranged or mounted or provided within the frame.

However, the examiner has not provided any explanation in the statement of the rejection before us in this appeal as to why the appellants' disclosure, considering the level of ordinary skill in the art as of the date of the appellants' application, would not have enabled a person of such skill to make and use the appellants' invention **without undue experimentation**. Factors that an examiner must consider in determining whether a disclosure would require undue experimentation include (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims.⁴

In this case, the examiner has not properly weighed the above-noted factors. While the examiner in the response to argument section of the answer (pp. 4-6) has pointed out various design considerations which one skilled in the art would need to take into account in building a boomer for generating acoustic signals in a marine

⁴ See In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988) citing Ex parte Forman, 230 USPQ 546, 547 (Bd. Pat. App. & Int. 1986).

seismic survey, the examiner has not met his burden of proof by advancing acceptable reasoning sufficient to establish that the appellants' disclosure would not have enabled a person of such skill to make and use the claimed invention **without undue experimentation** considering the level of ordinary skill in the art.

Since the examiner has not met the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention for the reasons set forth above, the decision of the examiner to reject claims 1 to 11 under 35 U.S.C. § 112, first paragraph, is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 11 under 35 U.S.C. § 112, first paragraph, is reversed.

REVERSED

LAWRENCE J. STAAB
Administrative Patent Judge

JOHN P. McQUADE
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

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